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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/239,873	01/29/1999	CINDIE M. LUHMAN	LL11.12-0040	6642

164 7590 01/24/2002

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EXAMINER

LEVY, NEIL S

ART UNIT	PAPER NUMBER
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1616

DATE MAILED: 01/24/2002

16

Please find below and/or attached an Office communication concerning this application or proceeding.



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16

DATE MAILED:

This is a communication from the examiner in charge of your application.  
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### OFFICE ACTION SUMMARY

☒ Responsive to communication(s) filed on 10/6/01

☐ This action is FINAL.

☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 D.C. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s) or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

#### Disposition of Claims

- ☒ Claim(s) 1-56 are permitted in the application.
- ☐ Claim(s) 5-7, 12, 15-27 is/are withdrawn from consideration.
- ☐ Claim(s) 1-4, 8-11, 13, 14, 28-56 is/are allowed.
- ☐ Claim(s) 1-56 is/are rejected.
- ☐ Claim(s) 1-56 is/are objected to.
- ☒ Claim(s) 1-56 are subject to restriction or election requirement.

#### Application Papers

- ☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.
- ☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.
- ☐ The proposed drawing correction, filed on \_\_\_\_\_ is ☐ approved ☐ disapproved.
- ☐ The specification is objected to by the Examiner.
- ☐ The oath or declaration is objected to by the Examiner.

#### Priority under 35 U.S.C. § 119

- ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- ☐ All ☐ Some\* ☐ None of the CERTIFIED copies of the priority documents have been
- ☐ received.
- ☐ received in Application No. (Series Code/Serial Number) \_\_\_\_\_
- ☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

\*Certified copies not received: \_\_\_\_\_

- ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e).

#### Attachment(s)

- ☒ Notice of Reference Cited, PTO-892
- ☒ Information Disclosure Statement(s), PTO-1449, Paper No(s). 14
- ☐ Interview Summary, PTO-413
- ☐ Notice of Draftsperson's Patent Drawing Review, PTO-948
- ☐ Notice of Informal Patent Application, PTO-152

-SEE OFFICE ACTION ON THE FOLLOWING PAGES-

Receipt is acknowledged of IDS (8/24/01) and amendment (10/16/01).

Claims 5-7, 12, 15-27 are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected inventions and species, there being no allowable generic or linking claim. Applicant timely traversed the restriction (election) requirement in Paper No. 7.

This application contains claims 5-7, 12, 15-27 are drawn to an invention nonelected with traverse in Paper No. 7. A complete reply to the final rejection must include cancellation of nonelected claims or other appropriate action (37 CFR 1.144) See MPEP § 821.01.

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1, 2 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-4 of copending Application No. 09/338,314. Although the conflicting claims are not identical, they are not patentably distinct from each other because the rejection of record stands.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claims 1, 8-10, 29-32, 34-37, 44-53 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. The rejection of record is maintained.

Claims 1, 8-10, 29-32, 34-37, do not specify ruminally protected, and the specification clearly indicates that feeding requires ruminally protected forms (p. 4, line 18-line 3, p. 5). See references Remond, Makinen. Claims 44-53, again, the specification explains sugar alcohols, but examiner finds only 2 associated with these claimed increases, it being an open question whether or not other alcohols will work. Examiner does not find patentable protection warranted for speculation, thus, the claims should be limited to what is known by applicant.

Claims 1-3, 9-11, 13, 28, 33, 38-43 are rejected under 35 U.S.C. 102(b) as being anticipated by Merensalmi 4127676.

The rejection of record is maintained.

Claims 1, 8-10, 13, 14, 29-32, 34-37 are rejected under 35 U.S.C. 102(b) as being anticipated by Khalili et al '97.

Dairy cows were fed glycerol (p. 351, top), with resultant increase in milk fat, total lactose, protein and mil yield, when given with fatty acids (p. 360). There is no

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statement that the glycerol was supplied to the abomasums; but as in the instant invention, simply providing a feed is what Khalili also did; the abomasums follows.

Claims 1, 9, 10, 13 are rejected under 35 U.S.C. 102(b) as being anticipated by Makinen et al '81.

Here too, sugar alcohols (p.1079) were fed to dairy cows, and not degraded in the rumen (p. 1086). Thus, since the same treatment; providing feed with sugar alcohols, is done as instantly claimed, the same results inherently would result; the measured parameter was enzyme activity. (Fig. 1).

Claims 1, 9, 10 and 13 are rejected under 35 U.S.C. 102(b) as being anticipated by Remond et al '86.

Sorbitol fed to dairy cows (p. 2) was not significantly absorbed or fermented in the rumen (p. 4,5). Thus, here too, the effects of the instantly claimed invention are inherently the same.

Claims 1-4, 9-11, 13, 28, 33 are rejected under 35 U.S.C. 102(b) as being anticipated by Smith et al 5219596.

Smith feed compositions which contain sugar alcohols (col. 2) to the abomasums, with resultant increase in milk production components (Table 2).

Applicant's arguments filed 10/16/01 have been fully considered but they are not persuasive. Applicants arguments have been considered and rejections restructured in accord with arguments, or withdrawn. As claimed, where claims are broaden in scope than the specification provides for the prior art is presented which shows applicant's method steps—feeding at least one sugar alcohol to lactating cows. These claims are

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not patentable over the art of record. Claims 44-53 are not seen as obvious, but could be construed to be anticipated absent specification of particular sugar alcohols and amounts thereof that bypass the rumen. Please note also that one milk production component is total weight, wet.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Neil Levy whose telephone number is (703) 308-2412. The examiner can normally be reached on Tuesday-Friday 7 am-5:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jose Dees can be reached on (703) 308-4628. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 308-4242 for regular communications and (703) 308-4556 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1235.

Levy:mv  
January 9, 2002



NEIL S. LEVY  
PRIMARY EXAMINER